

Remarks

Upon entry of this amendment, claims 1-21 and 30-40 are in the application, of which claims 1, 7, 13, 15, 32, 36, 37, and 39 are in independent form. Claims 33-39 are added by this amendment without introducing new matter.

Applicant thanks the examiner for the courtesies extended to the undersigned attorney during the March 16, 2011 telephone interview. During the interview, the examiner indicated that proposed amendments to add a “format tester” to claim 1 would overcome Reulein, but would require further searching. The examiner also indicated that at least some of the other amendments proposed by applicant during the interview would be likely to raise new issues requiring further search and/or examination. The examiner's comments were noted and the proposed amendments have been adjusted to avoid raising new issues by the amendments to claims 6 and 12, as discussed below. Thus, applicant requests prompt consideration of this amendment on the record and issuance of an advisory action, if appropriate. To the extent that only some of the amended claims do not raise new issues requiring further search and are in condition for allowance, applicant requests an indication of allowability of such claims in an advisory action.

Claims 1-4, 7-10, 15, 16, and 30-32 stand rejected under 35 U.S.C. § 102(e) as anticipated by US 7,035,837 of Reulein et al. (“Reulein”). Under 35 U.S.C. § 103(a) the office action rejects as unpatentable: (1) claims 5 and 11 over Reulein in view of US 2002/0065852 of Hendrickson; (2) claims 6 and 12 over Reulein in view of US 2002/0111963 of Gebert et al. (“Gebert”); and (3) claims 13, 14, and 17-21 over Reulein in view of US 2002/0019786 of Gonzalez et al. Applicant respectfully requests reconsideration in view of the amendments to the claims, discussed below. With respect to the rejection of claims 6 and 12, applicant *traverses* and respectfully requests reconsideration, in view of the remarks below concerning claims 6 and 37.

Claims 1, 13 and 15

Claims 1 and 13, directed to systems for producing documents, are amended to recite that the document production processor includes a *format tester* for assisting the user to select one of the formats to be used by the document production processor to generate a user-requested document from a marked-up document and the user-selected format. Similarly, claim 15 is amended to recite the step of “assisting a user to select one of a plurality of stored

formats” used in the claimed method of producing documents. Support for these amendments is found in the specification at page 5, line 28, and in FIG. 1 illustrating two-way flow of information between the format tester 18 and the interactive web server 12. Reulein does not teach a format tester. For this reason, applicant believes amended claims 1, 13, and 15 are allowable over the prior art and respectfully requests the same.

Claims 2, 3, 8, and 9

Claims 2 and 8 are amended to specify that the marked-up document includes a plurality of minor structural mark-up elements that contain text, and which are included in the generated user-requested document. Claims 3 and 9 are amended to specify that the minor structural mark-up elements include one or more of words, characters, lines, and special paragraphs. Support for the amendments to claims 2, 3, 8, and 9 is found at page 4, lines 20-24, and page 8, line 26 to page 9, line 19. As explained in the specification:

“minor structural elements are required to flow into the rendition, and in that sense the flow is an immutable rule that cannot be affected by the user formatting. The granularity of ‘minor’ structural elements can be as fine as individual words or characters, which would allow control over formatting down to the word or character level . . .”

An example of a character-level minor structural element is the lowercase letter ‘b’, which persons with dyslexia often confuse with the lowercase letter ‘d’. Including text-containing minor structural mark-up elements in a marked-up document enables systems according to the claims to apply formatting rules at the character or word level that may aid a reader in discriminating between characters, for example, and thereby potentially help a person with dyslexia to differentiate between the character ‘b’ and the character ‘d’ in words. Minor structural mark-up elements including words may enable special formatting for words of a particular grammatical type, or adding information to the text, such as foreign language equivalents and pictograms, for example, as explained at page 9, lines 15-35.

The prior art does not disclose the use of minor structural mark-up elements containing text in marked-up documents and the use of such minor structural mark-up elements for generating a formatted output document utilizing a user-selected format. Nor does the prior art disclose minor structural mark-up elements including words, characters, lines, or special paragraphs. Thus, claims 2, 3, 8, and 9 are believed to be allowable over the prior art and applicant respectfully requests the same.

Claims 6, 12 and 37 and 39

Claims 6 and 12 are amended in several respects. First, all instances of XML:FO in claims 6 and 12 (and elsewhere throughout the claims) are corrected to read XSL:FO, consistent with the original specification. Second, claims 6 and 12 are amended to conform the claim terminology with antecedent terminology and to clarify the distinction between the “XSL:FO style sheet”, which is created from the XML format file defining the user-selected format, and the “XSL:FO file”, which is created from the XSL:FO style sheet and the user-requested marked-up document. The amended claims more clearly reflect the two-stage process inherent in original claims 6 and 12 and further described in the specification at page 6, lines 5-15 (describing the “Style Sheet Builder” which creates the XSL:FO style sheet 27 and the “XSLT Processor” which applies the XSL:FO style sheet to the marked-up document to produce the XSL:FO file). The amendments to claims 6 and 12 are clarifying in nature without changing the effective scope of the claim, and should not raise new issues requiring further search or examination.

New independent claim 37 incorporates the language of unamended claim 1 (without the format tester added by the present amendment to claim 1 discussed above) and the language of claim 6, as amended herein. Claim 37 also limits the marked-up documents to the form of XML files, which is consistent with the main embodiment described in the specification. Thus the scope of claim 37 is consistent with the scope of claim 6 before the present amendments and should not raise new issues requiring further search or examination.

New independent claim 39 incorporates the language of unamended claim 1 (without the format tester added by the present amendment to claim 1 discussed above) and the language of claim 6, as amended herein, except that claim 39 calls for the formats to be stored in a “database”, whereas claim 1 recites a “document format store” for storing the formats.

Claim 6 and 12 currently stand rejected under 35 U.S.C. § 103(a) over Reulein in view of Gebert. Applicant *traverses* and respectfully requests reconsideration in view of the following remarks.

With reference to paragraphs 0005-0008; 0014; 0023; 0030; and 0042 of Gebert, the Office Action asserts that Gebert teaches a production processor that creates an XSL:FO style sheet from the format file, creates an XSL:FO file from the marked-up document (was XML document), and generates an output file from said XML:FO file representing the user-

requested document. Applicant is unable to find, anywhere in the cited paragraphs or elsewhere within Gebert, any teaching of a two-stage process of the kind claimed by claims 6, 12, 37, and 39. Specifically, Gebert does not appear to teach a style sheet builder or any other means for generating a style sheet from a user-selected format, which style sheet is then applied to a marked-up document to create an XSL:FO file, as claimed.

When determining whether a claim is obvious, the examiner is required make "a searching comparison of the claimed invention - including all its limitations - with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Thus, an obviousness determination requires the Office action to identify and address all limitations of a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Where, as here, the references cited in the Office action fail to disclose all of the claimed elements and the missing elements are not addressed by the Office action, the Office Action fails to make out a *prima facie* case of unpatentability. For this reason, and because the clarifying amendments to claim 6 raise no issues requiring further search, claims 6, 12, 37, and 39 should be allowed.

Claims 33 and 34

New claims 33 and 34 are directed to features of the system enabling the user to specify parameters of the stored formats. Support for new claims 33 and 34 is found in the specification at page 5, lines 1-26. These features are not believed to be taught by the prior art, and claims 33 and 34 are therefore believed to be in condition for allowance.

Claims 38 and 40

Claims 38 and 40 depend from respective claims 37 and 39, and are directed to an iterative process by which the XSL:FO style sheet is re-created in response to the XSL:FO file, then the XSL:FO file is re-created from the re-created XSL:FO style sheet and the user-requested marked-up document. Support for claims 38 and 40 is found in the original specification at page 6, lines 5-15 and FIG. 1. The claimed style-sheet feedback and iterative creation of XSL:FO files is not believed to be taught or suggested by the prior art, and claims 38 and 40 are therefore believed to be in condition for allowance.

Other Amendments

New claim 35 depends from claim 1. Support for claim 35 is found in the original specification at page 5, lines 29-31.

New independent claim 36 is based on unamended claim 1 (without the format tester added by the present amendment to claim 1 discussed above) and incorporates the limitations of claims 2 and 3, as amended.

Claims 4, 5, 11, 30 and 31 are amended for clarity and to conform to American spelling for “color”, without changing the scope of the claims or adding new matter.

Conclusion

Applicant believes the claims are in condition for allowance. If the examiner believes there are issues remaining, he is invited to contact the undersigned attorney by telephone to expeditiously advance the application. In the event the examiner determines that new grounds for rejection are applicable to amended claims that were, in essence, previously presented (*i.e.*, claims amended for clarity only), the new grounds should be presented in a new non-final Office action and the applicant given a fair opportunity to respond. MPEP § 706.07(a) (“second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement”).

The Commissioner is hereby authorized to charge any fees which may be required in connection with filing of this paper, or credit overpayment, to Deposit Account No. 19-4455.

Respectfully submitted,

Objective Systems Pty Ltd.

By /s/Kassim M. Ferris/
Kassim M. Ferris
Registration No. 39,974
Direct Dial: (503) 294-9670

STOEL RIVES LLP
900 SW Fifth Avenue, Suite 2600
Portland, OR 97204-1268
Telephone: (503) 224-3380
Facsimile: (503) 220-2480